

II. Applicants' Traversal of the Examiner's Requirement for an Election between the Asserted "Species" of Group (I)

If the Examiner insists on requiring an election between claims 2 and 7, Applicant traverses such an election requirement for the following reasons.

1. The Examiner has Not Established a *Prima Facie* Case for the Election Requirement

Regarding the asserted "species" of claims 2 and 7 within group I, the specification discloses that the curing assembly 516 shown in FIG. 5C is operable to concurrently implement both of the processes recited in claims 2 and 7 (see page 16, line 23 - page 17, line 2). Therefore, the asserted "species" are related.

In the case of related inventions, MPEP § 806.05(j) explains that, for related process inventions that are not in a combination/subcombination relationship, the inventions are distinct if (emphasis added):

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; and
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct, but the example need not be documented.

In addition, MPEP § 808.01 reads as follows (emphasis added):

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

The only "explanation" given by the Examiner in support of the election requirement is the following statement (§ 4, first ¶ on page 3 of the Office action):

These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In this "explanation," the Examiner has not attempted to address any of the prong (A)-(C) of MPEP § 806.05(j). The Examiner has not provided any showing whatsoever the asserted "species" of claims 2 and 7 are mutually exclusive, nor has he shown that the asserted "species" of claims 2 and 7 are not obvious variants, nor has he shown that the asserted "species" of claims 2 and 7 are either not capable of use together or can have a materially different design, mode of operation, function, or effect. Instead, the Examiner has applied an incorrect standard in support of the election requirement.

For the reasons explained above, the Examiner has not made the showing required under MPEP § 806.05(j) and, consequently, has not established a *prima facie* basis for requiring an election between the asserted "species" of claims 2 and 7.

2. No Valid Reason Exists for Dividing Among the Related Inventions

In general, if "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions" (MPEP § 808.02).

In support of the proposed requirement for an election between the "species" of claims 2 and 7, the Examiner has not provided any basis for believing that the classifications of the asserted "species" of claims 2 and 7 is not the same or would be different in the future. Indeed, the Examiner has failed to show how the classification is different between any of the asserted "species" of claims 2 and 7. Thus, the Examiner has not shown that separate examinations are required for the asserted "species" of claims 2 and 7. Accordingly, under MPEP § 808.02, "no reasons exist for dividing among related inventions" and the election requirement should be withdrawn for this additional reason.

III. Conclusion

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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